



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,910	03/30/2004	Yutaka Takami	566.35562CX2	3171
20457	7590	12/30/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,910

Applicant(s)

TAKAMI ET AL.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-30 is/are allowed.
- 6) ☒ Claim(s) 31-40 and 43-46 is/are rejected.
- 7) ☒ Claim(s) 41 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This is in response to the Applicant's reply of 10/28/2004.

The double-patenting rejection that had been made is withdrawn in view of the terminal disclaimer that has been filed. Other rejections are maintained for reasons discussed in the '**Response to Arguments**' section below. Please see that section for a detailed opinion by the Examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-40 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al. (US 4,959,788). Nagata teaches the elements and means recited in claims 31-40 and 44-46. For example, Nagata teaches the following:

Re claim 31: A card is shown in figure 2. An input/output port is shown in figure 2, ref. 1, which acts as a transmission unit and a reading/writing unit, in conjunction with RAM and ROM on the card. An operation control unit is present, namely a CPU (ref. 2 in figure 1) connected RAM, ROM and input/output. See figures 3 and 6: money information is stored in the card in RAM. Study the entire document, but especially

Art Unit: 2876

column 2, lines 42-46; column 2, lines 52-59; column 7, lines 18-29. As described in column 7, lines 18-29, a user can specify on the card, using the keypad, a "payment amount" (line 25). This payment amount will later be transferred in a single transaction (i.e. in a lump sum) at a later transaction time. The lump sum instruction module and transmission unit in both cases is simply the CPU. Further operation and entry of data again by the user is unnecessary (column 3, lines 10-16) because data has been pre-entered and does not have to be entered at the time of transaction.

Re claim 32: A lump sum drawing instruction module and detection unit are both the CPU of the card. The difference between this claim and claim 31 is that here the user pre-enters in to the IC card an amount to withdraw in one transaction, for example from an ATM. This is described in detail in column 7, lines 38-56, as well as throughout the document.

Re claim 33: See discussion re claim 31 above, and note that a 'YES' button (column 15, lines 1-10) is a submit button that essentially confirms lump sum operations (see also figures 19a-19c). Note that although the transaction does not happen immediately but later, nothing in the claim language indicates that the transaction takes place immediately on 'confirming' it.

Re claim 34: See discussion of claim 32 and also of claim 33, regarding 'button.'

Re claims 35/36: See figure 2: ref. 13 is a display.

Re claims 37/38: See figure 2: The keypad 12 allows the user to enter an amount. See also column 7, lines 23-25, 31-33, 46-48 where amount data is entered for different types of transactions.

Art Unit: 2876

Re claim 39: See figures 17/18 and column 5, lines 37-43: An ATM is explicitly mentioned.

Re claim 40: See claim 39 discussion, above, and also column 12, line 55. Savings balance is stored on the card. Where else would it come from but the banking machine. Many figures show the card interacting with the ATM machine.

Re claim 43: See discussion re claims 31/33.

Re claim 44: The 'YES' button is employed for the purpose of confirmation of various transactions, a.k.a. lump sum operations.

Re claim 45: See discussion re claims 31 and 33 above.

Re claim 46: See discussion re claim 44 above.

Allowable Subject Matter

Claims 17-30 are allowed, being similar to various corresponding claims in 6,382,505, a terminal disclaimer having been filed.

Claims 41 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art known to the examiner fails to teach or fairly suggest a card which both pre-entering withdrawal data directly on the card prior to the transactions as per all of the limitations of claim 34 in addition to displaying an on the card amount that has been transferred to the card after the transaction has completed as per all of the limitations of claim 41.

Response to Arguments

Applicant's arguments filed 10/28/2004 have been fully considered but they are not persuasive.

The applicant has argued, on pages 17 and 18 of recent arguments, that a particular aspect is lacking in the art cited by the examiner. "As one example, as described in Applicant's figure 6 and on specification page 18, information on a value of electronic money which can be obtained from an external device (e.g. cash register)..."

The examiner observes that these aspects are not in the language of the claim.

In general, Examiner notes that various attributes which limit the scope of the invention should be directly written into the claims as limitations. Although the claims are to be read in light of the specification, the specification should not be considered a substitute for the claims; nor should limitations be "read into" the claims from the specification. The claims are to be given their broadest reasonable interpretation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2876

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH

DANIEL STCYR
PRIMARY EXAMINER

